

Application number 09/618,971  
Amendment dated May 23, 2004  
Reply to office action mailed November 24, 2003

PATENT

REMARKS/ARGUMENTS

After entry of this amendment, claims 1-19 and 31-43 will remain pending in this application. Claims 1, 3, 31, 33, 34, 35, 36, and 38 have been amended. Claims 20-30 have been cancelled without prejudice. Support for the amended claims can be found in the specification, no new matter has been added.

Claims 3, 33, 35, and 38 stand rejected under 35 U.S.C. 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. Claims 1-7, 19, and 31-39 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. patent no. 6,460,172 in view of U.S. patent no. 5,668,507. Claims 8 and 40 stand rejected under 35 U.S.C. 103(a) as being unpatentable over '172 in view of '507 and further in view of U.S. patent no. 5,193,070. Claims 9-13, 15, and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over '172, in view of '507 and '070, and further in view of U.S. patent application 2001/0049806. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over '172, in view of '507, '070, and 2001/0049806, and further in view of U.S. patent no. 5,563,524. Claims 16, 17, and 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over '172, in view of '507, '070, and 2001/0049806, and further in view of U.S. patent no. RE37,500. Claims 18 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over '172, in view of '507, and further in view of U.S. patent no. 6,625,557. Claims 23-25, 28, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over '172, in view of '507, '070, 2001/0049806, and RE37,500, and further in view of U.S. patent no. 5,754,764. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over '172, in view of '507, '070, 2001/0049806, and RE37,500, and further in view of U.S. patent nos. 5,754,764 and 5,563,524. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over '172, in view of '507, '070, 2001/0049806, RE37,500, and '764, and further in view of '524 and U.S. patent no. 4,831,510. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over '172, in view of '507, '070, 2001/0049806, RE37,500, and '764, and further in view of '510.

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Claim 1

Claim 1 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Insenser Farre (In) in light of Boerstler et al (Bo). But these references do not show or suggest each and every element of this claim. For example, claim 1 as amended recites: "providing the digital circuit portion, the design of which is based on the testing of the analog circuit version while modifying the configuration of the emulation circuit." Neither of the cited references provide this feature.

Bo teaches using noise generators in evaluating test circuits. This information may then be used to allow the designers to "determine and consider noise suppression techniques and design modifications to reduce the detrimental effects of the digital switching noise on the analog (or sensitive digital) circuit." ( see Bo, column 3, lines 8-11) In other words, Bo teaches evaluating and then modifying the analog circuit, not the digital portion.

Further, while the noise generators in Bo may be programmable, they are programmable so that the analog portion may be evaluated, not so that the digital circuit portion design may be "based on the testing of the analog circuit version while modifying the configuration of the emulation circuit" as required by the claim.

For at least these reasons, claim 1 should be allowed.

Claim 31

Claim 31 stands rejected under 35 U.S.C. 103(a) as being unpatentable over In in light of Bo. But these references do not show or suggest each and every element of this claim. For example, claim 31, as amended, recites: "providing said digital circuit portion, wherein said digital circuit portion may be formed by rewiring said emulation circuit." Neither of the cited references provide this feature.

Rather, Bo teaches using noise generators on a chip with a test circuit for the evaluation of the test circuit. There is no mention of reconnecting the noise generators to form a digital circuit portion as required by the claim.

For at least this reason, claim 31 should be allowed.

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Other claims

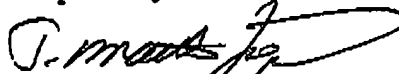
Claim 36 should be allowed for similar reasons as claim 1. The other claims depend on claim 1, 31, and 36, and should be allowed for at least the same reasons, and for the additional limitations they recite.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this application are in condition for allowance. The issuance of a formal notice of allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-752-2456.

Respectfully submitted,



J. Matthew Zigmant  
Reg. No. 44,005

TOWNSEND and TOWNSEND and CREW LLP  
Two Embarcadero Center, Eighth Floor  
San Francisco, California 94111-3834  
Tel: 650-326-2400 Fax: 415-576-0300  
Attachments  
JMZ:djb  
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